



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/978,217	11/25/97	BENZ	C 02307E-07111

HM12/1010  
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EXAMINER  
HOLLERAN, A

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 10/10/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/978,217

Applicant(s)

BENZ ET AL.

Examiner

Anne Holleran

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13, 16-18, 21-26, 71, 79 and 82-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 88 and 89 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 16-18, 21-26, 71, 79 and 82-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. The amendment filed July 9, 2001 is acknowledged.

Claims 5, 14, and 20 were canceled.

Claims 84-89 were added.

Claims 1-4, 6-13, 16-18, 21-26, 71, 79, and 82-89 are pending and examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections Maintained:***

3. The rejection of claims 1-4, 6-9, 16-19 and 21-26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained for the reasons of record.

The rejection of claims 1 and 16 because of the phrase “specifically hybridizes under stringent conditions” is maintained. Applicant’s arguments have been carefully considered but are unpersuasive. A claim to a polynucleotide where hybridization language is used is a product-by-process claim. Thus, the claim is indefinite if the process is not claimed with defined metes and bounds.

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4. The rejection of claims 1, 2, 6-14, 21-26, 82 and 83 is maintained and made against new claims 86 and 87 under 35 U.S.C. 102(e) as being anticipated by Kola et al, (U.S. Patent 5,789,200; issue Aug. 4, 1998; effective filing date Oct. 31, 1996).

Applicant presents no specific arguments why this rejection should be withdrawn. New claims 86 and 87 appear to be claiming the same subject matter as that of claim 2 and a species encompassed by claim 6.

5. The rejection of claim 79 is maintained and applied to new claims 84 and 85 under 35 U.S.C. 102(e) as being anticipated by Kola et al, (U.S. Patent 5,789,200; issue Aug. 4, 1998; effective filing date Oct. 31, 1996).

The rejection is maintained for the reasons of record, and made against claims 84 and 85, which depend from claim 79. Applicant presents no specific arguments why this rejection should be withdrawn.

6. The objection to claim 79 is maintained and further applied to new claims 84 and 85, which depend from claim 79. Applicant's arguments appear to be directed to a traverse of the restriction requirement made in Office action mailed 5/24/1999. Applicant's traverse of this restriction requirement was unpersuasive and made final in Office action mailed 3/30/2000.

7. Claims 1, 4, 6-13, 16, 21-26, 71, 79, 82 and 83 is maintained, and made against new claims 84, 85 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejections are maintained for the reasons of record. The rejection of new claims 84 and 85, dependent from claim 79, are made because the limitations of claims 84 and 85 do not limit the breadth of the scope to what is described. Applicant's arguments are unpersuasive because applicant fails to establish that the functional limitation "encoding a transcription factor" limits the breadth of the claimed genera to inventions for which the disclosure of SEQ ID NO: 1, SEQ ID NO: 2, SEQ ID NO: 15, and SEQ ID NO: 16 are representative embodiments. The family of transcription factors encompasses a broad range of structurally different compounds. Coupled with the fact that there are no metes and bounds around the hybridization language, the claims encompass widely varying structures for which the disclosure of the embodied polynucleotides is not representative.

### *Conclusion*

Claims 88 and 89 are allowable. Claims 1-4, 6-13, 16-18, 21-26, 71, 79, and 82-87 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Office should be directed to Anne Holleran, Ph.D. whose telephone number is (703) 308-8892. Examiner Holleran can normally be reached Monday through Friday, 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached at (703) 308-3995.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0196.

ALH

Anne L. Holleran  
Patent Examiner  
October 9, 2001



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